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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,130	01/07/2002	Clifford A. Pickover	YOR920010296US1	2408

28062 7590 10/18/2005

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EXAMINER

LANEAU, RONALD

ART UNIT PAPER NUMBER

3627

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,130

Applicant(s)

PICKOVER ET AL.

Examiner

Ronald Laneau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 25-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 and 25-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The amendment filed on 08/18/05 has been entered. Claims 24 and 25 are canceled and claims 1-23 and 26-52 are now pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-23 and 26-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAuliffe (US 2003/0004798) in view of Henson (US 6,167,383).

As per claims 1-11, 13-17, 23, 26-41 and 43-51, McAuliffe discloses a method for online shopping (electronic commerce), including the steps of: associating an online shopping cart with a consumer (page 11, [0007], lines 1-8); consumer selects the items to place in the shopping cart and consumer is associated to the shopping cart); and associating an item with the online shopping cart (page 3, [0024], lines 8-12); items are stored in the shopping cart and are therefore associated to the shopping cart). McAuliffe does not disclose a method wherein the associated item was not selected by the consumer for association with the shopping card but Henson discloses merchandizing recommendations that can be provided based upon the contents of the shopping cart, the shopping cart merchandising messaging presents to the user an additional effort to checkout by the online store vendor to advertise merchandise or service, or further recommended items for the user to purchase. Furthermore, Henson discloses the merchandizing

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recommendations that are provided from the database into the shopping cart and once a desired system is configured by a customer, the configured system can then be added to the shopping cart.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the automatic recommendations of items in the shopping cart s taught by Henson into the system of McAuliffe because it would improve customization of the online store by adding features such as additional items into the shopping cart.

As per claim 2, McAuliffe discloses a method wherein the item is associated with the shopping cart based on at least one of: a shopping history of the consumer (page 4, [0038], lines 10-13).

As per claim 3, McAuliffe discloses a method further comprising: determining to associate the item with the online shopping cart based on a first item associated with the shopping cart Page 1, [0008], lines 14-16).

As per claim 4, McAuliffe discloses a method wherein the item is complementary to the first item (page 1, [0007]; lines 11-13).

As per claim 5, McAuliffe discloses a method wherein the item is a substitute for the first item (page 1, [0007], lines 14-17)

As per claim 6, McAuliffe discloses a method comprising: determining to associate the item with the online shopping cart based on a characteristic of items previously associated with the shopping cart (page 1, [0007], lines 14-17).

As per claim 7, McAuliffe discloses a method wherein the characteristic comprises at least a type of one or more of the items (page 3, [0029], lines 6-8).

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As per claim 8, McAuliffe discloses a method including the step of determining to associate the item with the online shopping cart based on a characteristic (behavior) of the consumer (page 3, [0029], lines 9-10.

As per claim 9, McAuliffe discloses a method wherein the characteristic comprises at least one shopping history (page 4, [0038], lines 11-14).

As per claim 10, McAuliffe discloses a method wherein a cost of the associated item is less than a retail cost that would be charged to the consumer for the item if the item was selected by the consumer for association with the shopping cart (page 3, [0025], lines 11-13).

As per claims 11 and 13-17, McAuliffe discloses a method wherein merchants determine the price of the item being offered for sale i.e. less than a retail cost). McAuliffe discloses a charge for associating an item into the shopping cart for consumers to purchase i.e. the cost of the associated item must be free as claimed. Furthermore, McAuliffe discloses a method further comprising: receiving an instruction from the consumer to disassociate a second item from the shopping cart; and in response to the instruction, automatically disassociating the item from the shopping cart (page 1, [0009], lines 3-12; upon consumer's return of item, enticement is altered to disassociate the second item from the shopping cart); comprising: presenting terms (financing term) for purchasing the item to the consumer (page 3, [0029], lines 16-19); further comprising determining the association based on rules (page 2, [0012], lines 3-7); comprising: dynamically updating the rules (page 3, [0025], lines 18-20); further comprising: notifying the consumer that the item was associated with the shopping cart (page 5, [0041], lines 8-14);

As per claims 12 and 22, McAuliffe does not disclose does not disclose that a method wherein an item cannot be disassociated from the shopping cart but it is obvious for McAuliffe's

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system to prevent an item from being removed from the shopping card once associated therein because it would allow a user of the system to make a decision on whether or not to purchase the supplemental item at the time of checkout.

As per claim 18, 19 and 21, McAuliffe discloses a method for online shopping (electronic commerce), comprising: associating an online shopping cart with a consumer (page 11, [0007], lines 1-8); and associating an item with the online shopping cart (page 3, [0024], lines 8-12) in response to a selection of the item by an entity other than the consumer (page 1, [0007], lines 10-13; entity = merchant = seller); wherein the entity is a potential seller (merchant) of the item (potential seller = merchant); wherein a cost of the associated item is less than a retail cost that would be charged to the consumer for the item if the item was selected by the consumer for association with the shopping cart (page 3, [0025], lines 11-13; merchants determine the price of the item being offered for sale i.e. less than a retail cost). Furthermore, McAuliffe discloses a method further comprising: receiving an instruction from the consumer to disassociate a second item from the shopping cart; and in response to the instruction, automatically disassociating the item from the shopping cart (page 1, [0009], lines 3-12; upon consumer's return of item, enticement is altered to disassociate the second item from the shopping cart).

As per claims 43-51, McAuliffe discloses an apparatus for electronic shopping (electronic commerce), comprising: a processor (fig. 2, engine 210); and a storage device in communication with the processor and storing instructions adapted to be executed by the processor (page 3, [0027], lines 6-10) to: associate an online shopping cart with a consumer (page 11, [0007], lines 1-8); and associate an item with the online shopping cart (page 3, [0024], lines 8-12), wherein the associated item was not selected by the consumer for association with the shopping cart

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(page 1, [0007], lines 10-13; the system provides consumer with an opportunity to buy additional items that were not selected with an enticement). McAuliffe further discloses a method wherein the item is associated with the shopping cart based on at least one of: a shopping history of the consumer (page 4, [0038], lines 10-13); a method further comprising: determining to associate the item with the online shopping cart based on a first item associated with the shopping cart Page 1, [0008], lines 14-16), wherein the item is complementary to the first item (page 1, [0007], lines 11-13); wherein the item is a substitute for the first item (page 1, [0007], lines 14-17); wherein a cost of the associated item is less than a retail cost that would be charged to the consumer for the item if the item was selected by the consumer for association with the shopping cart (page 3, [0025], lines 11-13; merchants determine the price of the item being offered for sale i.e. less than a retail cost); wherein the entity is a potential seller of the item (potential seller = merchant). McAuliffe does not disclose a charge for associating an item into the shopping cart for consumers to purchase i.e. the cost of the associated item must be free as claimed.

4. Claims 20, 42 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAuliffe (US 2003/0004798) in view of Henson (US 6,167,383) and further in view of Batachia et al (US 2002/0116349).

As per claims 20, 42 and 52, McAuliffe does disclose an intelligent buyer agent 290 in fig. 2) but does not disclose a merchant or an entity other than the consumer using an intelligent agent but Batachia is used to show that the concept of utilizing an intelligent between the consumers and the merchants is old and well known in the art.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the automatic recommendations of items in the shopping cart s taught by Henson into the system of McAuliffe because it would improve customization of the online store by adding features such as additional items into the shopping cart. And it would have been obvious to one of ordinary skill in the art to utilize the intelligent agent as taught by Batachia into the combined systems of McAuliffe and Henson because it would improve the negotiation capability between consumers and merchants and also enable to operate reliably, efficiently and profitably on behalf of their clients (merchants or consumers).

Response to Arguments

5. Applicant's arguments filed on 08/18/05 have been fully considered but they are not persuasive.

Applicant argues that McAuliffe fails to disclose or suggest "associating an item with a shopping cart in response to a selection of the item by an entity other than the consumer." In response to Applicant's arguments, Henson is used to disclose such features. The previous response to arguments in regards to McAuliffe stand (see previous rejection). Applicant further argues that McAuliffe does not disclose a method wherein the item cannot be disassociated from the shopping cart. Contrary to Applicant's arguments, eventhough McAuliffe does not explicitly discloses such features but it would have been obvious to prevent the additional items from being removed from the shopping card in order to increase the chance of selling said additional items to the consumer. Applicant's arguments are deemed unpersuasive, claims 1-23 and 26-52 remain rejected.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (571) 272-6784. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald Laneau

Ronald Laneau
Examiner
Art Unit 3627

10/13/05

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